RECEIVED
CENTRAL FAX CENTER
OCT 25 2004

MOTOROLA

Intellectual Property Section
Law Department

FAX COVER SHEET

DATE: OCTOBER 25, 2004

TO: EXAMINER YANG, R.R. — 703-308-6133
(ADDRESSEE'S NAME) (EXTENSION)
ART UNIT 2672 — 703-872-9306
(LOCATION) (FAX NUMBER)

FROM: MATTHEW C. LOPPNOW — (847) 523-2585
(SENDER'S NAME) (EXTENSION)

RE: 09/855,388

TOTAL NUMBER OF PAGE(S) 17 (INCLUDING THIS PAGE)

Personal Communications Sector
600 North U.S. Highway 45, AN 475
Libertyville, IL 60048
Phone: (847) 523-2322 Facsimile: (847) 523-2350

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 703-872-9306) on the date indicated below.

Signature _____ Date October 25, 2004
Matthew C. Loppnow

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: REED et al. EXAMINER: Yang, R.

SERIAL NO.: 09/855,388 GROUP: 2672

FILED: May 15, 2001 CASE NO.: PF02077NA

ENTITLED: METHOD AND APPARATUS FOR PROCESSING DATA INCLUDING AN IMAGE FOR PRESENTATION ON A DISPLAY

Motorola, Inc.
Intellectual Property Department
600 North U.S. Highway 45
Libertyville, IL 60048

APPEAL BRIEF UNDER 37 C.F.R. § 1.192(c)

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed on August 24, 2004, Applicant submits the present Appeal Brief.

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST

The real party in interest is, Motorola, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-7, 9-13, and 15-19 are pending. Claims 8, 14 and 20 were canceled. Claims 1-7, 9-13, and 15-19 are rejected and are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the May 3, 2004 final rejection.

V. SUMMARY OF INVENTION

The inventions are drawn generally to a method and apparatus for processing data including an image for presentation on a display (page 1, lines 6-8). For example, the invention is drawn to locating a position on at least one of first and second display portions compatible with a display for displaying the image (page 5,

lines 10-12, Fig. 8, element 810) and displaying the image in the position such that, when the position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of a visible seam is omitted (page 5, lines 12-16, Fig. 8, element 812).

VI. ISSUES

Whether claims 1, 9, and 15 are patentable under 35 U.S.C. § 103 over Sakaihara and McNelley because there is no motivation to combine the references.

VII. GROUPING OF CLAIMS

Claims 1-7, 9-13, and 15-19 stand or fall together regarding the rejection under 35 U.S.C. § 103.

VIII. ARGUMENT

Claim Limitations At Issue

In Claim 1, the limitations at issue are italicized below:

1. A method for processing data including an image for presentation on a display having a first display portion and a second display portion, the first and

second display portions separated by a visible seam having a location and a width, the method comprising the steps of:

locating a position on at least one of the first and second display portions for displaying the image; and

displaying the image in said position such that, *when said position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of the visible seam is omitted,*

wherein *the data includes attributes for controlling at least one of scaling and placement of the image on the display and identifying important areas of the image,* and

wherein the locating step comprises the step of scaling and locating the image and protecting the important areas in accordance with the attributes.

Examiner's Allegation

Claims 1, 9, and 15 stand rejected under 35 U.S.C. § 103 over Sakaihara et al. (JP PN 02-79090) and McNelley (U.S. Patent No. 5,438,357).

Applicants' Argument

Applicants assert there is no motivation to combine Sakaihara and McNelley to recite the features taught in independent claims 1, 9, and 15.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Sakaihara is directed to electronic stained glass (Title) such as drawing patterns on drawings on window glass and using pictures to change a room interior (Task, solved by the invention section). McNelley is directed to a teleconferencing system (Title, Field, Summary, Description of the Preferred Embodiment, and Claims). There is absolutely no disclosure in Sakaihara of any usefulness of Sakaihara's electronic stained glass in a teleconferencing system, such as that disclosed by McNelley. Furthermore, there is absolutely no disclosure in McNelley of any usefulness of McNelley's teleconferencing system with electronic stained glass. The original Office Action did not explain how one reference teaches the usefulness of using it with the other reference. In particular, the original Office Action only mentioned generic benefits of each reference after making a conclusory statement that the combination of such would be obvious. No motivation had been provided for combining one reference with the other.

In the "Response to Arguments" section, the final Office Action alleges motivation is based on the fact that "both Sakaihara and McNelley's inventions are in the field of electronic display device." However, this does not amount to proper

motivation. If the Office Action is trying to insinuate that the fact that the inventions can be combined because they are in the same field, Applicants disagree. In particular, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Yet, as discussed below, the prior art does not suggest the desirability of the combination. Furthermore, that fact that inventions are in the same field does not provide sufficient motivation to combine two particular references. There is absolutely no basis for such motivation. Thus, the mere fact that both Sakaihara and McNelley's inventions are in the field of electronic display devices does not provide proper motivation to combine the references.

The Office Action further alleges motivation is based on ensuring an important part of the image is displayed. However, this does not amount to proper motivation. In particular, there is no disclosure of such a necessity for Sakaihara. More particularly, Sakaihara is directed to electronic stained glass. Yet, the Office Action admits McNelley only states, "tight head shots would require a quick tracking response..." However, there is no disclosure that Sakaihara uses tight head shots which would require a quick tracking response. In fact, there is no disclosure of any feature in Sakaihara that would require a quick tracking response. Sakaihara only deals with drawing patterns on window glass and using pictures to change a room interior. These patterns and pictures are not disclosed to be dynamic or involving the tracking of a moving object. Thus, there is no need for a quick tracking response to ensure an important part of an image is displayed. Furthermore, there is no

disclosure in Sakaihara of using images that have important parts that need to be displayed. Additionally, there is no disclosure in McNelley of ensuring an important part of an image is displayed on the electronic stained glass of Sakaihara. Thus, ensuring an important part of an image is displayed does not amount to proper motivation to combine the references.

Thus, the Office Action has not provided proper motivation to combine Sakaihara and McNelley to recite the features taught in independent claims 1, 9, and 15.

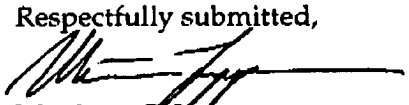
Therefore, Applicants respectfully submit that independent claims 1, 9, and 15 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103.

Kindly reverse and vacate the rejection of Claims 1, 9, and 15 under 35 U.S.C. § 103 with instructions for the Examiner to allow all pending Claims 1-7, 9-13, and 15-19 to issue as a United States Patent.

CONCLUSION

In view of the discussion above, the Claims of the present application are in condition for allowance. Kindly withdraw any rejections and objections and allow this application to issue as a United States Patent without further delay.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Phone No. (847) 523-2585

Dated: October 25, 2004

Fax No. (847) 523-2350
Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048

IX. APPENDIX

Claims involved in the appeal:

1. (previously presented) A method for processing data including an image for presentation on a display having a first display portion and a second display portion, the first and second display portions separated by a visible seam having a location and a width, the method comprising the steps of:

locating a position on at least one of the first and second display portions for displaying the image; and

displaying the image in said position such that, when said position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of the visible seam is omitted,

wherein the data includes attributes for controlling at least one of scaling and placement of the image on the display and identifying important areas of the image, and

wherein the locating step comprises the step of scaling and locating the image and protecting the important areas in accordance with the attributes.

2. (original) The method of claim 1, wherein the locating step comprises the step of repeatedly moving the image back and forth perpendicular to the visible seam during a time period, such that the portion of the image corresponding to the

position of the visible seam differs with time, thereby allowing a display of potentially omitted portions of the image during part of the time period.

3. (original) The method of claim 1, wherein the locating step comprises the step of moving the image back and forth perpendicular to the visible seam, in response to a user input through a user interface.

4. (original) The method of claim 1, wherein the displaying step comprises the step of scaling the image for presentation on a display surface having a size and aspect ratio compatible with the first and second display portions aligned adjacent to one another and separated by more than the width of the visible seam.

5. (original) The method of claim 1, wherein the locating step further comprises the steps of:

processing the image to identify predetermined important features of the image; and

locating the image such that the predetermined important features do not fall within the portion of the image corresponding to the position of the visible seam.

6. (previously presented) The method of claim 1, wherein the locating step further comprises the step of positioning the image wholly in one of the first and second display portions.

7. (original) The method of claim 1,

wherein the data also includes text, and

wherein the method further includes the step of wrapping the text to fit into areas of the first and second display portions not used for displaying the image.

8. (canceled)

9. (previously presented) An apparatus for processing data including an image for presentation on a display having a first display portion and a second display portion, the first and second display portions separated by a visible seam having a location and a width, the apparatus comprising:

an input interface for accepting the data;

a processor coupled to the input interface for processing the data; and

an output interface coupled to the processor for outputting the processed data,

wherein the processor is programmed to:

determine a location of a position on at least one of the first and second display portions for displaying the image; and

process the data for displaying the image in said position such that, when said position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of the visible seam is omitted,

wherein the data includes attributes for controlling at least one of scaling and placement of the image on the display and identifying important areas of the image, and

wherein the processor is further programmed to scale and locate the image and protect the important areas in accordance with the attributes.

10. (original) The apparatus of claim 9, wherein the processor is further programmed to repeatedly move the image back and forth perpendicular to the visible seam during a time period, such that the portion of the image corresponding to the position of the visible seam differs with time, thereby allowing a display of potentially omitted portions of the image during part of the time period.

11. (original) The apparatus of claim 9, wherein the processor is further programmed to scale the image for presentation on a display surface having a size and aspect ratio compatible with the first and second display portions aligned adjacent to one another and separated by more than the width of the visible seam.

12. (original) The apparatus of claim 9, wherein the processor is further programmed to:

process the image to identify predetermined important features of the image; and

locate the image such that the predetermined important features do not fall within the portion of the image corresponding to the position of the visible seam.

13. (original) The apparatus of claim 9,

wherein the data also includes text, and

wherein the processor is further programmed to wrap the text to fit into areas of the first and second display portions not used for displaying the image.

14. (canceled)

15. (previously presented) A electronic device for processing data including an image, comprising:

an input interface for accepting the data;

a processor coupled to the input interface for processing the data; and

a display coupled to the processor for displaying the processed data, the display having a first display portion and a second display portion, the first and second display portions separated by a visible seam having a location and a width;

wherein the processor is programmed to:

determine a location of a position on at least one of the first and second display portions for displaying the image; and

process the data for displaying the image in said position such that, when said position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of the visible seam is omitted,

wherein the data includes attributes for controlling placement of the image on the display and identifying important areas of the image, and

wherein the processor is further programmed to locate the image and protect the important areas in accordance with the attributes.

16. (original) The electronic device of claim 15, wherein the processor is further programmed to repeatedly move the image back and forth perpendicular to the visible seam during a time period, such that the portion of the image corresponding to the position of the visible seam differs with time, thereby allowing a display of potentially omitted portions of the image during part of the time period.

17. (original) The electronic device of claim 15, wherein the processor is further programmed to scale the image for presentation on a display surface having a size and aspect ratio compatible with the first and second display portions aligned adjacent to one another and separated by more than the width of the visible seam.

18. (original) The electronic device of claim 15, wherein the processor is further programmed to:

process the image to identify predetermined important features of the image; and

locate the image such that the predetermined important features do not fall within the portion of the image corresponding to the position of the visible seam.

19. (original) The electronic device of claim 15,

wherein the data also includes text, and

wherein the processor is further programmed to wrap the text to fit into areas of the first and second display portions not used for displaying the image.

5

20. (canceled)